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08/655,853	05/30/1996	HAROLD A. MCMASTER	GLT-1540-R	9175
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BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			VINCENT, SEAN E	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 08/655,853

Filing Date: May 30, 1996

Appellant(s): MCMASTER ET AL.

MAILED

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GROUP 1700

Earl J. LaFontaine
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the appeal brief filed September 10, 2001 appealing from the Office action mailed March 9, 2001.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct. Upon reconsideration, the examiner has withdrawn the rejection of claims 27 and 30 over 35 USC 112 first paragraph.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claims 27 and 30 under 35 USC 112 paragraph 1.

(7) Claims Appendix

Claim 30 contain(s) substantial errors as presented in the Appendix to the brief. Accordingly, claim 30 is correctly written in the Appendix to the Examiner's Answer.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:
Claim 27 is rejected under 35 U.S.C. 251. This rejection is set forth in prior Office Action, Paper No. 73.

(10) Response to Argument

In response to the argument that the applicant did not surrender the right to claim a tempering station in application 07/083,675 (not 07/083,685 as stated in the reply brief), the examiner disagrees. The Applicant is relying on the title and specification of the later filed application 07/249,718 (Pat 488527) to support allegations that an apparatus solely for tempering was not intended to be surrendered in the previously filed application 07/083,675. It is the position of the examiner that the subject matter cannot be “un – surrendered”. Moreover, removal of the claims to apparatus only for tempering constituted a surrender and subsequent filing of an application with no claims to apparatus only for tempering would reinforce the original surrender.

As requested by the Board of Patent Appeals and Interferences in the Remand mailed July 27, 2005, a detailed analysis of appealed claim 27 relative to surrendered subject matter is presented herein. This analysis is based on Chapters 1412.02 and 1412.03 of the newly revised MPEP 8th ed. Rev 4 (October 2005). As stated by the MPEP:

”In Clement, 131 F.3d at 1468-70, 45 USPQ2d at 1164-65, the Court of Appeals for the Federal Circuit set forth a three step test for recapture analysis. In Pannu, 258 F.3d at 1371, 59 USPQ2d at 1600, the court restated this test as follows:

Application of the recapture rule is a three-step process.

The first step is to 'determine whether and in what aspect the reissue claims are broader than the patent claims.'....

'The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter'

Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule. [Emphasis added]”

Step One: In the present reissue application, the reissue claim 27 is directed to “An apparatus for uniformly tempering a glass sheet...” which is broader than claim 1 of US 4,883,527 (or claims 2-16 of ‘527 or claims 1-11 of US 4,822,398) directed to “A glass bending and tempering apparatus...”. Reissue claim 27 lacks the “actuator for deforming the platen from a planar shape to a bent shape to bend the heated glass sheet” from claims 1-11 of McMaster et al ‘398 or even the “actuator being constrainable and having the ability to lift portions of said first platen a controlled distance to form the desired bent shape in the glass sheet” from McMaster et al ‘527(emphasis added).

The omission of aspects:

- a) a bending function in the preamble of claim 27 and
- b) an actuator to bend the heated glass sheet or form the desired bent shape in the glass sheet in the body of claim 27

results in a clear broadening of the patented claims of US 4,822,398 and US 4,883,527. In other words, claim 27 is broader in the aspect of not providing a means (or a function) for bending glass sheets.

Step Two: As explained in the Final Rejection mailed March 9, 2001, claims 12-14 of 07/083,675 (not 07/083,685 as incorrectly stated therein) were canceled in response to the prior art rejection over Kahle et al and a personal interview conducted on April 13, 1988. Surrender was established by deleting claims not having the critical bending limitation of the claim, rather

than by adding the bending limitation to claims not originally containing such. The subject matter of canceled claims 12-14 is what the examiner considers to be the surrendered subject matter. The surrendered subject matter was a glass sheet tempering apparatus with no actuator to bend a glass sheet. In comparison, the claims allowed from 07/083,675 were glass bending and tempering apparatus which included "an actuator for deforming the platen from a planar shape to a bent shape to bend the heated glass sheet".

Therefore, the broadening aspects discovered in step one above relate to the surrendered subject matter because lack of a means and function for bending glass sheets relates to a lack of a means and function for bending glass sheets.

Step Three:

The NEWLY REVISED MPEP states:

"When analyzing a reissue claim for the possibility of impermissible recapture, there are two different types of analysis that must be performed. If the reissue claim "fails" either analysis, recapture exists.

First, the reissue claim must be compared to any claims canceled or amended during prosecution of the original application. It is impermissible recapture for a reissue claim to be as broad or broader in scope than any claim that was canceled or amended in the original prosecution to define over the art. Claim scope that was canceled or amended is deemed surrendered and therefore barred from reissue. *In re Clement, supra*.

Second, it must be determined whether the reissue claim entirely omits any limitation that was added/argued during the original prosecution to overcome an art rejection. Such an omission in a reissue claim, even if it includes other limitations making the reissue claim narrower than the patent claim in other aspects, is impermissible recapture. *Pannu v. Storz Instruments Inc., supra*. However, if the reissue claim recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection (and therefore not entirely removing that key limitation), then the reissue claim may not be rejected under the recapture doctrine. *Ex Parte Eggert, 67*

USPQ2d 1716 (Bd. Pat. App. & Inter. 2003) (precedential). For example, if the key limitation added to overcome an art rejection was "an orange peel," and the reissue claim instead recites "a citrus fruit peel", the reissue claim may not be rejected on recapture grounds."

In the present application, the reissue claim 27 passes the first test because it is narrower in all aspects than claims 12-14 canceled from 07/083,675. Several structures present in reissue claim 27 were not present in canceled claims 12-14. However, the reissue claim 27 fails the second test because the reissue claim 27 entirely omits a bending means which was present in the allowed claims of McMaster et al '527 and McMaster et al '398. More specifically, reissue claim 27 omits an actuator **to bend the heated glass sheet** and also an actuator **to form the desired bent shape in the glass sheet**.

Reissue claim 27 contains "an actuator connected to the lower platen so the quench tubes are movable as a glass sheet is bent **to generally conform the tubes to a desired bent shape of a glass sheet**" (emphasis added). This actuator is not a broader form of the bending actuator of the patented claims. This actuator is a tempering actuator with no bending function claimed and entirely different from the actuator to bend glass sheets that was in the patented claims. The applicant carefully drafted reissue claim 27 to **omit** all means of bending. The applicant did not draft the reissue claim to contain a more broad form of a bending means. Therefore, the decision of *Ex Parte Eggert, supra* is not applicable to the facts of this appeal. To summarize, the reissue claim 27 fails the second analysis of part three of the three-part test and so is "impermissible recapture".

In page 15 of the Remand of July 27, 2005, the Board stated "In contrast, a reissue claim narrower in scope than the canceled or amended claim in all aspects (i.e., a claim setting forth all

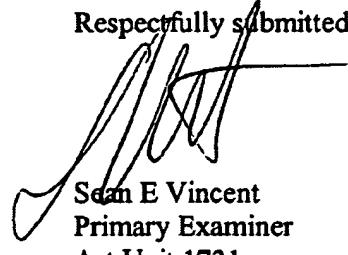
the limitations of the canceled or amended claim and adding a further narrowing limitation) escapes the recapture doctrine entirely." This position was justified in light of contentious nature of the recapture doctrine in the time frame between this examiner's 2001 Examiner's Answer and the present day. With all due deference to the Board of Patent Appeals and Interferences, it is the position of the examiner that the latest revision of the Manual of Patent Examining Procedure is the standard by which any reissue claim should be analyzed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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Primary Examiner
Art Unit 1731

Conferees:



Patrick Ryan



Steven Griffin

APPENDIX TO EXAMINER'S ANSWER

30. A glass sheet bending and tempering apparatus comprising: lower and upper opposed deformable platens each of which includes elongated quench tubes which extend in a spaced apart relationship to each other in the direction of conveyance of the glass sheet and have quench openings, the lower platen having deformable drive shafts which extend between the elongated quench tubes and are oriented to be generally transverse to the direction of travel of the glass sheet, and which deformable drive shafts are rotatably supported by those quench tubes, and the lower platen also having drive wheels supported on the deformable drive shafts thereof at spaced locations to engage and move the glass sheet to be bent; the upper platen having idler shafts mounted on the elongated quench tubes thereof and also having idler wheels mounted by the idler shafts at spaced locations to engage the glass sheet to be bent; actuating means for causing deformation of the lower platen with the upper platen being conformably deformable to the shape of the lower platen as the lower platen is bent from a flat shape to a bent shape with the glass sheet disposed between the platens as the quench openings of the elongated quench tubes and the wheels are moved with the platens as the wheels engage and bend the glass sheet; means to supply quenching gas to the quench openings of both platens after bending has finished to thereby temper the bent glass sheet between the platens; and drive means for driving the drive wheels to move the glass sheets during the bending and tempering of the glass sheet.